

REMARKS

Claims 1-8, 15-20, 55-86 were pending in the present application, of which claims 73-86 were withdrawn from consideration. With the instant Amendment, pending claims 1, 6, 18, and 63 are amended, and withdrawn claim 73 is amended. Upon entry of this amendment, claims 1-8, 15-20, 55-86 will be pending and claims 1-8, 15-20 and 55-72 will be under consideration.

I. Amendments to the Claims

Pending claims 1, 6, 18 and 63, and withdrawn claim 73 have been amended to delete the element “hydrogen” in their recitals for R¹. Applicants submit that these amendments are fully supported by the application as filed and present no new matter. In particular, the amendments to pending claims 1, 6, 18 and 63 and withdrawn claim 73 are supported by the specification at, for example, page 11, lines 16-19, page 14, lines 5-7, page 16, lines 27-29, and by claims 1, 6 and 18 as originally filed.

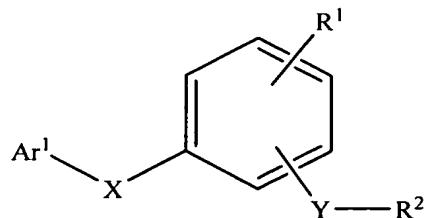
Pending claim 63 has been amended to recite in part “A composition comprising a pharmaceutically acceptable *carrier or excipient*” The amendment is supported by the specification at, for example, page 25, lines 26-28.

Accordingly, the amendments to the claims are fully supported by the application as filed and introduce no new matter.

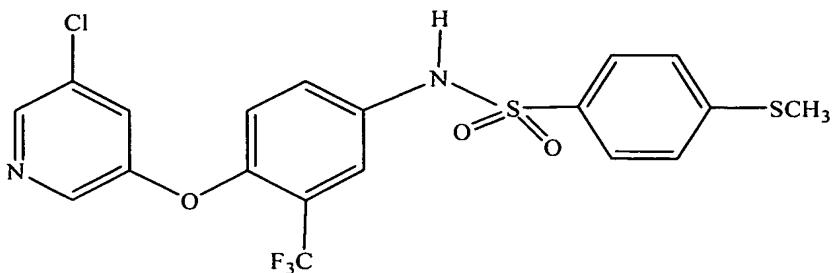
No claim amendment fee is believed to be due.

II. The Rejection of Claims 1-8, 15-20 and 55-72 Under 35 U.S.C. § 102(e) Should be Withdrawn

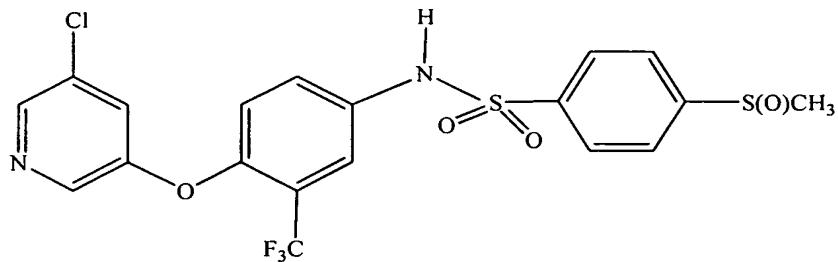
Claims 1-8, 15-20 and 55-72 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,620,827 (the '827 patent). According to the Examiner, “the patent teaches a markush of



and specific examples of



[Example 48] and

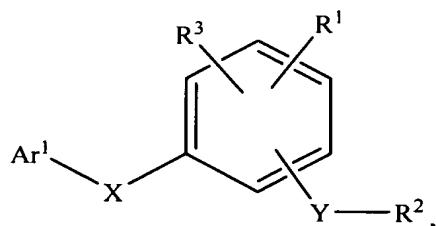


[Example 49]

that anticipate the instant claims.” See Office Action, pages 2 and 3.

To establish anticipation under 35 U.S.C. § 102, the Examiner must establish that each and every limitation of the claim is disclosed in the cited reference, either expressly or inherently. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The '827 patent, however, does not disclose or suggest any compounds encompassed within the amended claims. Applicants respectfully traverse this rejection.

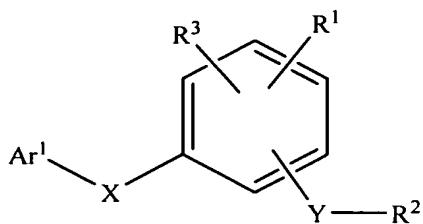
Amended claim 1 recites in part: “A compound having the formula:



wherein Ar^1 is a substituted or unsubstituted phenyl or a substituted or unsubstituted naphthyl; X is a divalent linkage selected from the group consisting of $-\text{O}-$, $-\text{C}(\text{O})-$, $-\text{S}(\text{O})_k-$ and $-\text{CH}_2-$...; Y is $\text{N}(\text{R}^{12})-\text{S}(\text{O})_m-$...; R^1 is a member selected from the group consisting of (C_2-C_8) heteroalkyl, aryl, aryl(C_1-C_4)alkyl, halogen, cyano, nitro, (C_1-C_8) alkyl, (C_1-C_8) alkoxy, $-\text{C}(\text{O})\text{R}^{14}$, $-\text{CO}_2\text{R}^{14}$, $-\text{C}(\text{O})\text{NR}^{15}\text{R}^{16}$, $-\text{S}(\text{O})_p-\text{R}^{14}$, $-\text{S}(\text{O})_q-\text{NR}^{15}\text{R}^{16}$, $-\text{O}-\text{C}(\text{O})-\text{OR}^{17}$, $-\text{O}-\text{C}(\text{O})-\text{R}^{17}$, $-\text{O}-\text{C}(\text{O})-\text{NR}^{15}\text{R}^{16}$, $-\text{N}(\text{R}^{14})-\text{C}(\text{O})-\text{NR}^{15}\text{R}^{16}$, $-\text{N}(\text{R}^{14})-\text{C}(\text{O})-\text{R}^{17}$ and $-\text{N}(\text{R}^{14})-\text{C}(\text{O})-\text{OR}^{17}$

...; R² is a substituted or unsubstituted phenyl; and R³ is a member selected from the group consisting of halogen, cyano, nitro and (C₁-C₈)alkoxy.”

Amended claim 63 recites in part: “A composition comprising a pharmaceutically acceptable carrier or excipient and a compound having the formula:



wherein ... R² is a substituted or unsubstituted aryl; and R³ is a member selected from the group consisting of halogen, cyano, nitro and (C₁-C₈)alkoxy.” The other variables are as defined in amended claim 1.

The '827 patent does not disclose or suggest phenylsulphonamide compounds wherein the central aromatic ring is di-substituted with an R¹ and an R³ substituent, and where neither R¹ nor R³ are hydrogen, as in amended claims 1 and 63. Instead, the '827 patent purports to disclose phenylsulphonamide compounds wherein the central aromatic ring is either unsubstituted (R¹ in the '827 patent is hydrogen) or mono-substituted (R¹ in the '827 patent is alkyl, heteroalkyl, aryl, etc.). See column 2, lines 35-41 of the '827 patent. See also Examples 48 and 49, above.

Further, the '827 patent does not disclose or suggest the particular groups defined for the second substituent, R³, as recited by instant claims 1 and 63. For example, in instant claim 1, R³ can be halogen, cyano, nitro or (C₁-C₈)alkoxy. No generic or specific compound disclosed by the '827 patent in either the claims or the specification comprises a halogen, cyano, nitro, or (C₁-C₈)alkoxy attached to a central aromatic ring, as recited by instant claim 1. Instead, the '827 patent purports to disclose phenylsulphonamide compounds wherein the central aromatic ring is substituted with hydrogen, alkyl, heteroalkyl, aryl, arylalkyl, -CO₂R¹⁴, -C(O)R¹⁴, -C(O)NR¹⁵R¹⁶, -S(O)_pR¹⁴, -S(O)_qNR¹⁵R¹⁶, -OC(O)OR¹⁷, -OC(O)R¹⁷, -OC(O)NR¹⁵R¹⁶, -N(R¹⁴)C(O)NR¹⁵R¹⁶, -N(R¹⁴)C(O)R¹⁷ or -N(R¹⁴)C(O)OR¹⁷. See column 2, lines 35-41 of the '827 patent. Accordingly, the instant claims, prior to entry of the instant amendments, are patentable over the '827 patent. Nevertheless, to more clearly distinguish the claimed subject matter from the '827 patent, Applicants have amended claims

1, 6, 18 and 63 to delete the element “hydrogen” in their recitals for R¹. Amended claim 1, 6, 18 and 63 are clearly distinguishable over the ’827 patent, as the ’827 patent does not disclose or suggest compounds wherein the central aromatic ring is di-substituted, as discussed above.

For at least the above reasons, the ’827 patent does not anticipate amended claims 1 and 63, or claims 2-8, 15-20 and 55-62 and 64-72 which depend therefrom.

Accordingly, Applicants respectfully request that the rejection of 1-8, 15-20 and 55-72 under 35 U.S.C. § 102(e) be withdrawn.

III. The Rejection of Claims 1-8, 15-20 and 55-72 under the Judicially-Created Doctrine of Obviousness-Type Double Patenting Should be Withdrawn

Claims 1-8, 15-20 and 55-72 stand rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-33 of U.S. Patent No. 6,620,827 (the ’827 patent). According to the Examiner:

Many examples *in the patent* contain the substituted phenyl ring (see examples 48 and 49). The difference between the instant claims and the claim of the patent is that the patented claims have an unsubstituted phenyl ring as compared to the instantly claimed substituted phenyl ring. However, it would have been obvious to one of ordinary skill in the art to make the unsubstituted or substituted phenyl ring due to the teachings *within the patent* with a reasonable expectation of success. (emphasis added)

See Office action, pages 4-5.

Applicants respectfully traverse this rejection and respectfully submit that no claim of the ’827 patent provides motivation to select the specific subgenus of compounds recited by claims 1-8, 15-20, and 55-72¹, including the specific R³ substituents of the formulas recited in these claims. As such, the ordinarily-skilled artisan would not regard the subject matter of claims 1-8, 15-20, and 55-72 as obvious variants of any claim of the ’827 patent.

Accordingly, Applicants respectfully request that the obviousness-type double patenting rejections of claims 1-8, 15-20, and 55-72 be withdrawn.

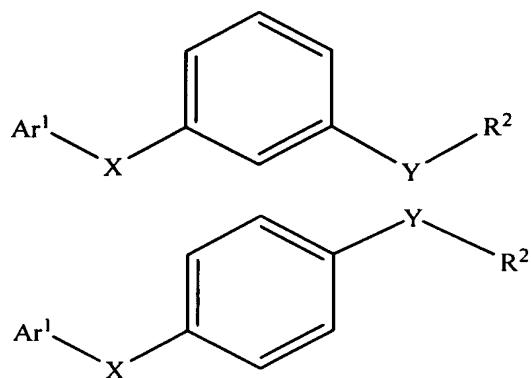
¹ Applicants note that claims 1-8, 15-20, and 55-62 relate to a particular genus of compounds, while claims 63-72 relate to compositions comprising such compounds. Thus, the compositions of claims 63-72 recite the genus of compounds recited by claims 1-8, 15-20, and 55-62, and thus Applicants address claims 1-8, 15-20, and 55-72 together.

A. The Legal Standard

Under the judicially-created doctrine of obviousness-type double patenting, a claim must be patentably distinct from a *claim* of an already issued patent or pending application. *See General Food Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992; emphasis supplied). If the claim at issue defines more than an obvious variation of the patented or pending claim, it is patentably distinct and rejection of the claim under the doctrine of obviousness-type double patenting is improper. *See id.* To establish a proper obviousness-type double patenting rejection, the Examiner must show that the claim at issue is a “mere variation” of the patented or pending claim that “would have been obvious to those of ordinary skill in the relevant art.” *See In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986). In the analysis, the “patent disclosure may not be used as prior art;” instead, the Examiner must focus on the “subject matter that *has been protected*, not ... something one may find to be disclosed by reading them” or the specification. *See General Food Corp.*, 23 U.S.P.Q.2d at 1846, quoting *In re Vogel*, 164 U.S.P.Q. 619, 622 (C.C.P.A. 1970) and *In re Boylan*, 157 U.S.P.Q. 370, 371 (C.C.P.A. 1968).

B. No Claim of the '827 Patent Suggests Selection of the Subgenus Recited by Claims 1-8, 15-20, and 55-72

The PTO argues that “it would have been obvious to one of ordinary skill in the art to make the unsubstituted or substituted phenyl ring due to the teachings *within the patent* with a reasonable expectation of success” (emphasis added). *See* Office action, page 5. Applicants maintain that the specification of the '827 patent cannot be used to construct a proper obviousness-type double patenting rejection. Rather, as discussed above, an obviousness-type double patenting rejection is only concerned with *what is claimed* by the prior patent. None of the claims of the '827 patent recite a substituent for the central phenyl ring. For example, claim 1 of the '827 patent recites a compound having one of the following formulae:



As such, the claims of the '827 patent define a genus that cannot possibly suggest selection of the particular substituents recited by the instant claims. Accordingly, the instant claims are *prima facie* nonobvious variants of the claims of the '827 patent.

Further, as discussed above, neither the claims nor the specification of the '827 patent disclose or suggest a di-substituted central aromatic ring or the particular substituents defined for the second substituent, R³.

For the above reasons, Applicants respectfully submit that the obviousness-type double patenting rejection is improper and earnestly request its withdrawal.

The Examiner is invited to call the undersigned, D. Pauling at (650) 739-3949, if she wishes to discuss the obviousness-type double patenting rejection of claims 1-8, 15-20 and 55-72.

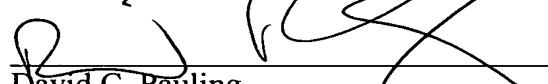
CONCLUSION

In light of the foregoing amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned at (650) 739-3949 if she believes a telephone call could expedite allowance of the instant claims.

No fee, other than the fee for submission of the Information Disclosure, is believed due with this response. However, should the Commissioner determine otherwise, the Commissioner is hereby authorized to charge any required fee(s) or credit any overpayment to Jones Day Deposit Account No. 50-3013 (order no. 893053-999123).

Date: December 30, 2008

Respectfully submitted,


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